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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/021,668	12/07/2001	Peter A. Graef	24393A	7057

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EXAMINER

STEPHENS, JACQUELINE F

ART UNIT PAPER NUMBER

3761

DATE MAILED: 09/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/021,668

Applicant(s)

GRAEF ET AL.

Examiner

Jacqueline F Stephens

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) 31-36 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-30 and 37-40 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 June 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 47 6) ☐ Other:

DETAILED ACTION

Election/Restrictions

1. This application contains claims directed to the following patentably distinct species of the claimed invention:

Species 1: a fibrous layer comprising a blend of crosslinked cellulosic fibers and noncrosslinked cellulosic fibers.

Species 2: fibrous layer having a midpoint desorption pressure greater than about 20 cm.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claim is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims

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are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

2. During a telephone conversation with Jack Crawford on 8/20/03 a provisional election was made with traverse to prosecute the invention of species 1, claims 1-30 and 37-40. Affirmation of this election must be made by applicant in replying to this Office action. Claims 31-36 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA

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1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-10 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 4-12 of copending Application No. 10013811. Although the conflicting claims are not identical, they are not patentably distinct from each other because the fibrous layer of both applications comprise the same percentage of crosslinked cellulosic fibers and noncrosslinked cellulosic fibers, as well as the same type of noncrosslinked cellulosic fibers. Therefore, the layer of the present application would inherently have the liquid uptake rate as claimed in independent claim 1 of 10013811. When the structure recited in the reference is substantially identical to that of the claims of the instant invention, claimed properties or functions are presumed to be inherent (MPEP 2112-2112.01). A *prima facie* case of either anticipation or obviousness has been established when the reference discloses all the limitations of a claim except a property or function and the

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examiner can not determine whether or not the reference inherently possesses properties which anticipate or render obvious the claimed invention but has basis for shifting the burden of proof as in *In re Fitzgerald*, 619 F.2d 67, 70 205 USPQ 594, 596 (CCPA 1980).

5. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-7, 10, 16, 25-30, and 37-40 are rejected under 35 U.S.C. 102(b) as being anticipated by Horney USPN 5549589.

As to claims 1, 37, and 39, Horney discloses an absorbent article **20/100** comprising a fibrous layer **24/108** comprising a refined blend (col. 7, lines 13-19) of crosslinked cellulosic fibers ('589 col. 4, lines 58-66) and noncrosslinked fibers ('589 col. 2, lines 36-51).

As to claims 2-4, Horney discloses the crosslinked cellulosic fibers are present in an amount from 20-80% based on the total dry web weight, which is included in the claimed ranges (col. 4, lines 58 through col. 5, line 1).

As to claims 5-7, Horney discloses the noncrosslinked cellulosic fibers are present in an amount from 10-80% based on the total dry web weight, which is included in the claimed ranges (col. 4, lines 58 through col. 5, line 1).

As to claim 10, Horney discloses the noncrosslinked cellulosic fibers comprise eucalyptus fibers (col. 6, lines 59-67).

As to claim 16, Horney discloses the layer comprises a wet strength agent (col. 8, lines 53-65).

As to claims 25, 38, and 40, Horney discloses an absorbent article **20/100** comprising a liquid distribution layer **24/108** and a liquid storage layer **25/106**, wherein the distribution layer comprises a refined blend (col. 7, lines 13-19) of crosslinked cellulosic fibers ('589 col. 4, lines 58-66) and noncrosslinked fibers ('589 col. 2, lines 36-51).

As to claims 26 and 27, Horney discloses the crosslinked cellulosic fibers are present in an amount from 20-80% based on the total dry web weight, which is included in the claimed ranges (col. 4, lines 58 through col. 5, line 1).

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As to claims 28 and 29, Horney discloses the noncrosslinked cellulosic fibers are present in an amount from 10-80% based on the total dry web weight, which is included in the claimed ranges (col. 4, lines 58 through col. 5, line 1).

As to claim 30, Horney discloses the storage layer comprises superabsorbent material (col. 10, lines 43-46).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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10. Claims 17-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horney. Horney discloses the present invention substantially as claimed. However, Horney does not disclose the claimed performance characteristics. In the present case, the reference has met the structural requirements of claim 1. Regarding the examiner's interpretation of the test and performance characteristics of the instant apparatus claims, when the structure recited in the reference is substantially identical to that of the claims of the instant invention, claimed properties or functions are presumed to be inherent (MPEP 2112-2112.01). A *prima facie* case of either anticipation or obviousness has been established when the reference discloses all the limitations of a claim except a property or function and the examiner can not determine whether or not the reference inherently possesses properties which anticipate or render obvious the claimed invention but has basis for shifting the burden of proof as in *In re Fitzgerald*, 619 F.2d 67, 70 205 USPQ 594, 596 (CCPA 1980).

11. Claims 8, 9, 11, 12, 14, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horney in view of Graef WO 98/51251.

As to claims 8 and 9, Horney discloses the present invention substantially as claimed. Horney discloses the absorbent composite comprises wood pulp fibers (col. 6, lines 52-67). However, Horney does not disclose the noncrosslinked cellulosic fiber comprises southern pine fiber or hardwood fibers. Graef shows that hardwood and southern pine fibers are equivalent wood pulp fibers known in the art (page 13, lines

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12). Therefore, because the two fibers were art-recognized equivalents at the time the invention was made, one of ordinary skill in the art would have found it obvious to substitute hardwood and southern pine fibers for the wood pulp fibers of Horney.

As to claims 11, 12, and 15, see Horney col. 4, lines 58-66.

As to claim 14, Horney/Graef does not specifically disclose the noncrosslinked cellulosic fibers are present in an amount in about 15 percent of the total weight of the layer. However, Horney/Graef recognizes the ratio of noncrosslinked to crosslinked fibers can be varied and this will affect density and retention capacity (col. 11, lines 42-56 and col. 12, lines 15-36). Horney/Graef, therefore recognizes the performance of the absorbent composite is a result effective variable of ratio of the fibers (Horney col. 2, lines 12-27). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the article of Horney/Graef with the claimed ratio of fibers, since discovering an optimum value of a result effective variable involves only routine skill in the art.

12. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Horney in view of Graef as applied to claim 11 above and further in view of Hoskins USPN 6059924.

Horney/Graef disclose the present invention substantially as claimed. However, Horney/Graef do not disclose the southern pine fibers have a Canadian Standard Freeness of about 500. Hoskins discloses it is important to perform only a mild

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mechanical refining of the southern pine fibers presenting a Canadian Standard Freeness in the range of 700-750 for the benefit of limiting the drop in pulp freeness as refining damages the outer surface of the individual pulp fibers (col. 5, lines 22-47). It would have been obvious to one having ordinary skill in the art to modify the invention of Horney/Graef to have southern pine fibers with the claimed Canadian Standard Freeness for the benefits disclosed in Hoskins.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacqueline F Stephens whose telephone number is (703) 308-8320. The examiner can normally be reached on Monday-Friday 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Weilun Lo can be reached on (703)308-1957. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3590 for regular communications and (703) 306-4520 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

Jacqueline F Stephens
Examiner
Art Unit 3761



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August 21, 2003